

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/454,492 Confirmation No.: 3808
Applicant : Claudio R. BALLARD
Filed : December 6, 1999
TC/A.U. : 3693
Examiner : Richard C. WEISSBERGER

For: REMOTE IMAGE CAPTURE WITH CENTRALIZED PROCESSING AND
STORAGE

**PETITION REQUESTING UNDER 37 CFR 1.181(a)(3) SUPERVISORY REVIEW OF
THE DECISION OF THE GROUP DIRECTOR MAILED DECEMBER 15, 2009
AND ALTERNATIVELY, UNDER 37 C.F.R. § 1.137(b) FOR REVIVAL
OF ABANDONED APPLICATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 5, 2010

Sir:

This communication is a petition seeking review under 37 CFR 1.181(a)(3) of the Decision of the Group Director mailed December 15, 2009, (hereinafter "Decision") which, rather than treating the petition then of record that requested withdrawal of the finality of the Final Office Action of July 15, 2009, held this application abandoned for an alleged failure to reply to the requirement for restriction mailed January 14, 2009, and, as such, dismissed the pending petition as moot. Petitioner specifically requests that the Commissioner of Patents exercise his supervisory authority by directing the Group Director

to withdraw the holding of abandonment of the above-identified application. In the alternative, if the holding of abandonment is not withdrawn, then Petitioner requests relief under 37 C.F.R § 1.137(b) for revival of the present application.

While 37 C.F.R. § 1.181(f), requires this Petition to be filed within two months of the Petition Decision of December 15, 2009, Petitioner respectfully requests that this requirement be waived or considered to be fulfilled although this Petition is filed after the two-month period but is filed before a three-month period, for the reasons discussed below. Additionally, with respect to this specific requirement, Petitioner respectfully requests that the PTO considers the fact that 1) it took a while for the Applicant/Petitioner of the instant application and the Applicant's representative (the undersigned) to investigate the matter at hand with the PTO, and 2) there was a delay in the investigation due to inclement weather that affected the Washington D.C. metropolitan area including the PTO and office of the undersigned which is located next to the PTO (for example, several severe snow blizzards closed the PTO and the office of the undersigned for a week or more during the past few months).

BACKGROUND

This application was filed over 10 years ago, and in that time has received 3 restriction requirements and but one, much abbreviated, action on the merits. The second action on the merits issued July 15, 2009 and has now supposedly been

vacated by the Decision, which of course undoes the little prosecution on the merits that the PTO has given this application over that same 10 years. This is a rather unfortunate treatment (or lack of treatment) of this application by the PTO, as the stated policy of the PTO is to accord special status to any application that has been pending for 5 years or more, and that every effort is to be made to finish the prosecution. See MPEP § 707.02. However, this application is twice as old as that triggering factor, and if the Decision is permitted to stand, sets back the ultimate resolution of the merits of this application even further. *Petitioner notes that the immediate parent application, and the continuation application of the instant application, have both issued as patents during the ten year pendency of the instant application.*

On January 14, 2009, the Examiner issued a requirement for restriction which sets a 30 day period for reply. A brief review of the restriction requirement reveals that it is highly and clearly improper.

Starting in late January, the undersigned's firm began a series of telephone and e-mail communications with the Examiner and his supervisor (SPE) to get this highly and clearly improper restriction requirement withdrawn and to advance prosecution by the Examiner to issue an Office action on the merits. The evidence of the existence of the telephone conversations and the e-mails relevant to this

objective were made of record on July 14, 2009, as attachments to a document captioned "Communication to the Office." It will be noted that the e-mail from the undersigned's firm to the Office dated February 10, 2009 (within the 30 day period), coupled with Examiner's reply copied to the SPE *some 8 minutes later* confirmed the mutual understanding that the restriction requirement was without force and effect.

On July 15, 2009, the long-requested Office action on the merits was mailed; incredibly it was made final and unfortunately it was so incomplete and inaccurate that no meaningful reply could be prepared.

Accordingly, on September 15, 2009, Applicant filed a petition seeking to have the finality withdrawn and a complete, corrective Office action on the merits issued so that prosecution could be furthered.

On December 15, 2009, the Decision was issued which (1) mooted the petition on the ground that this application had earlier become abandoned for an alleged failure to reply to the restriction requirement of January 14, 2009, such that the later Office action had no force and effect, (2) noted the aforementioned "Communication to the Office" but dismissed the e-mail correspondence between the PTO and petitioner as immaterial as supposedly lacking the necessary written authorization from Applicant, (3) further opined that the aforementioned e-mail(s) did not toll the outstanding response period, (4) noted that the emails spoke only of a

forthcoming vacatur, not that that the Office action had been vacated, and (5) even if the Examiner (who allegedly did not have such authority) had vacated the restriction requirement, a new Office action had to have been mailed prior to the expiry of the then running period for reply. The Decision concluded that since the next Office action was mailed July 15, 2009, the period had already expired, and as such that Office action could not have properly issued in an abandoned case, it had no force and effect, and was vacated. In turn, the Decision held, this mooted the request for review of the improper finality of the July 15, 2009 Office action.

ARGUMENT AND RELIEF REQUESTED

This application is not abandoned for failure to reply, or to properly reply, to the highly and clearly improper restriction requirement of January 14, 2009.

It is Petitioner's position that (1) a reply was timely filed, or in any event, (2) a proper reply to the outstanding restriction requirement was timely filed as evidenced by (a) the USPTO's own actions or inactions in this case, and (b) the documents already of record in this case, and (3) the Decision has improperly refused to accord any evidentiary force and effect to the e-mails issued by the PTO and Applicant.

The Decision clearly erred where it held that as there was no written

authorization from the Applicant to engage in e-mail communications (stating "no such internet communications should take place"), citing the USPTO Internet Usage Policy (hereinafter "IUP") as recounted in MPEP § 502.03. Thus, the Decision incorrectly seeks to improperly distance, disregard, and disavow, the very communications that show that, under the condition that this application required, a proper, full, and timely reply to the outstanding Office action had already been made, in writing, before February 14, 2009.

Those e-mails further show that a written, much less a verbal, meeting of the minds had occurred such that no further reply was necessary -- or indeed -- could righteously have been prepared by Applicant's representative on or before February 14, 2009.

The MPEP at section 711.02 sets forth the PTO test for abandonment:

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant "fails to reply" to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e., failure to file a "complete and proper reply, **as the condition of the case may require**" within the statutory period (37 CFR 1.135(b)). (emphasis added)

The Decision fails to appreciate that Applicant *did* file a "complete and proper reply as the condition of the case may require." The Decision contends that a response to the restriction requirement of January 14, 2009 was never

received, but in making this assertion, incorrectly opines that since there was no written authorization by Applicant, the e-mail communications between Applicant's representatives and the PTO were not authorized by the PTO's Internet Usage Policy ("IUP") as set forth in MPEP § 502.03. However, that section of the MPEP does not contradict the applicable IUP which is fully set forth at 64 FR 33056 (June 21, 1999). The IUP merely recognizes the fact that the internet can be inherently an insecure and unsafe medium and as the security and confidentiality of a given application cannot be guaranteed by the PTO, the applicant must expressly authorize communication via the internet when confidentiality is at stake and a response to an Office action on the merit is required.

The Decision is clearly incorrect in its opinion as it overlooks that (1) as set forth in MPEP section 103, subsection III, and 37 CFR 1.14(v), this application has long been made publically available by the PTO on the internet via PUBLIC PAIR as *it was not subject to the requirement for confidentiality when the e-mail correspondence occurred due to publication of its counterpart international application* no. PCT/US00/33010 as WO 2001/40979 on June 7, 2001, (reinforced by the pre-grant publication of continuation application no. 10/245,232 as document 2003-022569 A1 on December 4, 2003) and (2) moreover, since a

restriction requirement is a procedural matter that does not go to the merits of an invention (see e.g. MPEP 1705 subsection II), and *since the e-mails of all parties were all limited to non-substantive issues and non-confidential matter that did not involve the merits of the invention, Applicant's written authorization was not required for the e-mail communications to be proper, even if the confidentiality requirement had still applied to this application.* This is expressly addressed by the IUP at 64 FR 33057 at comment 4 and the PTO reply:

Comment 4: One comment suggested that **some simple or routine correspondence of a non-confidential nature** (e.g., interview scheduling requests, inquiries as to whether a document has been received by the examiner, inquiries as to an examiner's fax number, etc.) **should be permitted without requiring an advance authorization form even though a serial number of a patent application may be included in the e-mail communications.**

Response: A **written authorization from applicant is required only where applicant's Internet e-mail correspondence to the PTO contains information subject to the confidentiality requirement of 35 U.S.C. 122 and applicant wishes the PTO to respond via Internet e-mail to applicant's correspondence.** If applicant's e-mail correspondence to the patent examiner contains information subject to the confidentiality requirement of 35 U.S.C. 122 and there is no written authorization by applicant in the application file, the patent examiner may respond to applicant's e-mail correspondence by telephone, or other appropriate means (see Patent Internet Usage Policy Article 7). (emphasis added)

The Decision also improperly contends that the contested restriction had not been withdrawn prior to February 14, 2009, in that the contemporaneous e-mails issued by the PTO spoke of a future action. However this contention conveniently overlooks the clear refutation of that action by both the Examiner and his SPE, and

the realities of prosecution. Since Petitioner had taken the position that the third restriction requirement for this application issued on January 14, 2009, was highly and clearly improper, and moreover, since the SPE and the Examiner agreed with this assessment, Petitioner could not, in good faith, as the Decision would apparently have it, prepare any other reply, such as an election, to the highly and clearly improper restriction requirement, and debit the Petitioner (Applicant) for preparing a reply to that Office action. The Decision overlooks the fact that the restriction requirement *had already been repudiated, in writing, by the two PTO officials in charge of the examination of this application, before the due date for reply to that Office action.* What other kind of reply, besides the e-mails and telephone conversations, was warranted in this instance? What other reply, besides the e-mails and telephone conversations, could righteously be prepared in this instance when a large number of communications have been made to the Examiner and prosecution has been delayed for such a long period of time? Applicant could not also file a petition since the PTO has long held that the filing of a petition in of itself will not stay any period that may be running against an application. See 37 CFR 1.181(f). Under the "condition of this case", the "complete and proper reply" was the e-mail correspondence of Applicant that elicited the timely, written repudiation of the very action that the PTO now contends triggered abandonment due to an alleged

failure to reply by Applicant. To hold the application abandoned in this situation would be highly unjust and unfair.

The Decision further contends that withdrawal of an Office action is limited to the Director of the PTO, or those delegated officials of the PTO per MPEP § 1000. However a reading of that entire chapter fails to reveal support for the Decision's implicit contention that the Examiner or the SPE do not have the authority to withdraw an action or requirement that they themselves have issued. Indeed, implicit in the authority of the Examiner or the SPE to issue an Office action or restriction requirement is the power of that Examiner or SPE to withdraw that same Office action or restriction requirement. It is only necessary for an applicant to seek higher authority review of an examiner's Office action or restriction requirement in accordance with the delegation of authority in MPEP Chapter 1000 when that Examiner or SPE does not agree with Applicant that his Office action or restriction requirement is erroneous and does not withdraw that selfsame Office action or restriction requirement.

Here, both the Examiner (a Primary Examiner) and the SPE agreed with Applicant, *in writing*, that the restriction requirement of January 14, 2009 was nugatory before February 14, 2009. The Decision also appears to overlook that the PTO considers itself to be bound by written communications, per 37 CFR 1.2, such

as the e-mails issued by the PTO in this instance by its two officials. Moreover 37 CFR 1.2, last sentence, only prohibits reliance upon the verbal agreements between Applicant and the SPE and the Examiner when there is disagreement or doubt. There is no disagreement or doubt here—as evidenced by the contemporaneous e-mails of record, that both the Examiner and the SPE agreed that the restriction requirement was spurious before February 14, 2009. Indeed, the MPEP clearly states that an examiner may *sua sponte*: (1) *withdraw a restriction requirement*- see MPEP sections 811.03, 821.04; and (2) *withdraw a holding of abandonment upon reconsideration of the sufficiency of a previous reply*, see MPEP section 711.03(a), which are powers expressly delegated to the Examiner and relevant to this application.

Accordingly it is requested that the Decision be reviewed and its holding of abandonment be withdrawn as the previous e-mail communications filed by Applicant were, under the condition of this case, the “complete and proper reply.” It is further requested that the Office action of July 15, 2009, and Applicant’s reply be reinstated and that the Group Director be permitted to treat the merits of the petition filed September 15, 2009, as no longer being moot. Petitioner respectfully submits that to hold the instant application as being abandoned is unjust and unfair. In the alternative, and to save time if the holding of abandonment is withdrawn, it is

requested that this application be returned to the Examiner, who together with the SPE, per MPEP § 707.02, will prepare and issue a comprehensive and understandable Office action complete in all regards to the merits such that prosecution may be furthered.

ALTERNATIVE RELIEF REQUESTED

In the event that the Petition under 37 C.F.R. § 1.181 is not granted, then Petitioner requests alternative relief under 37 C.F.R. § 1.137(b) for revival of the present application.

37 C.F.R. § 1.137(b) provides that if the delay in reply by an applicant or a patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was

unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The Petitioner submits that:

(1) The papers filed on September 15, 2009, as previously filed, and the e-mail communications as documented, constitute a proper reply to be considered by the Examiner;

(2) The petition fee as set forth in § 1.17(m) (\$ 1,500) accompanies this Petition via the authorization to charge any necessary fees in connection with this Petition;

(3) Based on information and belief, Petitioner herein states that, the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and

(4) A terminal disclaimer is not required in the present situation since the period of delay, if any, would not extend the period of enforceability of any patent that may be granted from this application.

REQUEST FOR GUIDANCE

In the event that 1) this request is not granted, and it is held that the December 15, 2009 Decision correctly held this application to be abandoned for failure to reply to the highly and clearly improper restriction requirement, such that revival by petition under 37 CFR 1.137 is required, and 2) the communications discussed above are not considered a proper reply to the restriction requirement, as required under 37 CFR 1.137, then guidance is expressly requested as to what reply is to accompany a petition as required by 37 CFR 1.137(b)(1) for the instant application. As explained in MPEP 711.03(c) subsection II(A) “[g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.” Here, since the Decision predicates abandonment on an alleged failure to reply to the highly and clearly improper restriction requirement, would the PTO contend that Applicant will now have to prepare a meaningless reply to the repudiated requirement for a restriction requirement that was withdrawn?

CONCLUSION

The Petition Decision of December 15, 2009 by the Group Director improperly denied the Petitioner's request to withdraw the finality of the Final Office action of July 15, 2009, while improperly held the application to be abandoned. It is hereby

requested that the Commissioner exercise his supervisory authority and reverse the arbitrary and capricious decision by the Group Director and direct the Examiner to withdraw the finality of the Final Office action of July 15, 2009 and not hold the application to be abandoned. Alternatively, if the Petition under 37 C.F.R. § 1.181 is not granted, it is requested that the application be revived under 37 C.F.R. § 1.137(b).

A fee is not believed to be required by the filing of this Petition (Petition under 37 C.F.R. § 1.181). However, if any fees are required for consideration of any of the petitions filed herein (including the Alternative Petition under 37 C.F.R. § 1.137(b)), or to maintain pendency of the application, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-2929.

Docket P43312.A12
Appl. No. 09/454,492
Petition for Supervisory Review of the Decision of December 15, 2009

Please direct questions related to this Petition to the undersigned.

Respectfully submitted,
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March 5, 2010

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